



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,720	06/23/2003	Make Morris	12873/04604	8692

24024 7590 02/07/2006

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
----------	--------------

3743

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No. 10/601,720	Applicant(s) MORRIS ET AL.	
	Examiner Teena Mitchell	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 and 31-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20 is/are allowed.
- 6) ☒ Claim(s) 31-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-54 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 14-20, 23, 26-29, 32, 34, and 39 respectively of copending Application No. 11/157,089. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 31 of the instant application limitations can be found in claim 1 of application '089 the claimed method steps would have been obvious to one of ordinary skill in the art because they would have resulted from the use of the system of the instant application claim 31. With respect to claim 32 of the instant application, the limitations can be found in claim 2 of application '089. With respect to claim 33 of the

instant application, the limitations can be found in claim 3 of application '089. With respect to claim 34 of the instant application, the limitations can be found in claim 4 of application '089. With respect to claim 35 of the instant application, the limitations can be found in claim 5 of application '089. With respect to claim 36 of the instant application, the limitations can be found in claim 6 of application '089. With respect to claim 37 of the instant application, the limitations can be found in claim 7 of application '089. With respect to claim 38 of the instant application, the limitations can be found in claim 9 of application '089. With respect to claim 39 of the instant application, the limitations can be found in claim 10 of application '089. With respect to claim 40 of the instant application, the limitations can be found in claims 11 and 14 of application '089. With respect to claim 41 of the instant application, the limitations can be found in claims 11 and 15 of application '089. With respect to claim 42 of the instant application, the limitations can be found in claim 16 of application '089. With respect to claim 43 of the instant application, the limitations can be found in claim 17 of application '089. With respect to claim 44 of the instant application, the limitations can be found in claim 18 of application '089. With respect to 45 of the instant application, the limitations can be found in claim 19 of application '089. With respect to claim 46 of the instant application, the limitations can be found in claim 20 of application '089. With respect to claim 47 of the instant application, the limitations can be found in claim 23 of application '089. With respect to claim 48 of the instant application, the limitations can be found in claim 26 of application '089. With respect to claim 49 of the instant application, the limitations can be found in claim 27 of application '089, the claimed method steps would be obvious

to one of ordinary skill in the art because they would have resulted from the use of the system of the instant application claim 49. With respect to claim 50 of the instant application, the limitations can be found in claim 28 of application '089. With respect to claim 51 of the instant application, the limitations can be found in claim 29 of application '089. With respect to claim 52 of the instant application, the limitations can be found in claim 32 of application '089. With respect to claim 53 of the instant application, the limitations can be found in claim 34 of application '089. With respect to claim 54 of the instant application, the limitations can be found in claims 36 and 39 of application '089, the claimed method steps of application '089 would have resulted from the use of the device of instant application claim 54.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 55 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Burton et.al. (6,349,724).

With respect to claim 55, Burton in a breathing apparatus discloses: a variable speed blower (20) adapted to pressurize the breathing gas; a sensor (80, 195) adapted to sense a parameter associated with delivery of the breathing gas; a controller (82) in communication with the variable speed blower (20) and the sensor (80, 195) and adapted to adjust the speed of the blower in response to a difference between the sensed parameter and a first predetermined value during an inhalation state of a breathing cycle, detect a transition from the inhalation state to an exhalation state of the breathing cycle based at least in part on the sensed parameter, reduce the blower speed for a first time portion based at least in part on an exhalation unloading function, and increase the blower speed for a second time portion based at least in part on an exhalation loading function until the sensed parameter exceeds the first predetermined value (based on the controller (82), valves (37, 49, and 60), selector (62), control panel (110), data storage card (210) the device of Burton is fully capable of meeting the claimed functional limitations as the device can be programmed for patient data information, to select times, pressures, or other parameters for running the dual pressure gas delivery device (Col. 6, lines 60-67-Cols. 9).

With respect to claim 56, Burton discloses a blower (20); means for sensing a parameter associated with the delivery of the breathing gas (80, 195), means for adjusting a blower speed (82) in communication with the blower and the sensing means wherein the adjusting is in response to a difference between the sensed parameter and a first predetermined value during an inhalation state of a breathing cycle; means for detecting a transition from the inhalation state to an exhalation state of the breathing cycle (71) in communication with the sensing means, wherein the detecting is based at least in part on the sensed parameter; means for reducing the blower speed to drop a pressure associated with the delivery of the breathing gas (39) in communication with the blower and detecting means, wherein the reducing is for a first portion based at least on an exhalation unloading function; and means for increasing the blower speed (49) to increase a pressure associated with the delivery of the breathing gas in communication with the blower and the reducing means, wherein the increasing is for a second time portion based at least on an exhalation loading function until the sensed parameter exceeds the first predetermined value (based upon controller (82), valves (37, 49, and 60), selector (62), control panel (110), data storage card (210).

Response to Arguments

Applicant's arguments see Page 11 of the amendment, filed 11/23/06; with respect to 112 rejections of claims 16-30 have been fully considered and are persuasive. The 112 rejections of claims 16-20 have been withdrawn.

Applicant's arguments with respect to claims 16-30 have been considered but are moot in view of the new ground(s) of rejection.

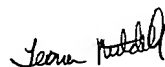
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show breathing devices: 6,866,040; 6,895,964; 6,823,866; 2003/0159695.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell
Primary Examiner
Art Unit 3743
January 26, 2006



TKM